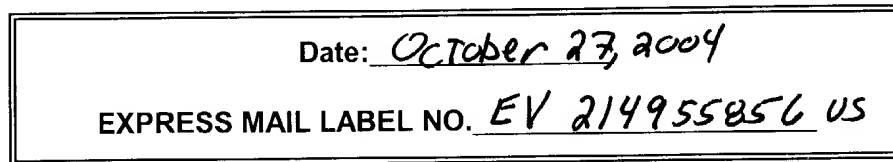


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sean McCarthy
Application No.: 09/009,802 Group: 1636
Filed: January 20, 1998 Examiner: David Guzo
For: NOVEL CRSP-2 PROTEIN MOLECULES AND USES THEREFOR (As Amended)



PETITION TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR
UNDER 37 C.F.R. § 1.181

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

This Petition is being filed to invoke the supervisory authority of the Director with respect to the "Sequence Listing" in the subject application. The facts are as follows:

1. The application was filed on January 20, 1998, with an unexecuted declaration, and without fees or a "Sequence Listing."
2. A Notice to File Missing Parts was mailed from the United States Patent and Trademark Office (USPTO) on March 4, 1998, requiring payment of the surcharge set forth in 37 C.F.R. § 1.16(e), the statutory basic filing fee and additional claims fees. The Notice to Filing Missing Parts did not include a Notice to Comply with Sequencing Rules 37 C.F.R. §§ 1.821-1.825. (Exhibit A; copy of Notice to File Missing Parts of Application dated March 4, 1998.)

3. A Response to Notice to File Missing Parts was filed in the USPTO on August 7, 1998. The Response included: Request for Three-Month Extension of Time and check for the required extension fee, Executed Declaration, Petition and Power of Attorney, Copy of Form PTO-1533, and a second check for the fees and surcharge. (Exhibit B; copy of postcard receipt stamped AUG 7 1998.)
4. A Preliminary Amendment with a "Sequence Listing" on substitute pages 75-101, Transmittal Letter for Diskette Containing Sequence Listing, and a computer diskette containing a copy of the "Sequence Listing" in computer readable form, were filed in the USPTO on October 13, 1998. (Exhibit C; copy of postcard receipt stamped OCT 13 1998.)
5. A Restriction Requirement with attached Notice to Comply With Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures and Error Report (Notice to Comply) was mailed from the USPTO on September 28, 1999. (Exhibit D, copy of Restriction Requirement with attached Notice to Comply.) The "Sequence Listing" filed on October 13, 1998 was held to not comply with 37 C.F.R. §§ 1.821-1.825 because some sequences contained "n" or "Xaa" but a Feature description was not provided. (See, Notice to Comply.) At page 2 of the Restriction Requirement, the Examiner stated that the application failed to comply with 37 C.F.R. §§ 1.821-1.825 for the reasons set forth in the Notice to Comply, and further stated:

Since the response appears to be **bona fide**, but through an apparent oversight or inadvertence failed to provide a complete response, applicant is required to complete the response within a time limit of one (1) month from the date of this letter, 37 CFR 1.135(c).

NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 C.F.R. 1.136(a) OR (b), BUT THE STATUTORY PERIOD FOR RESPONSE SET FOR THIS COMMUNICATION MAILED MAY BE EXTENDED UP TO A MAXIMUM OF SIX (6) MONTHS UNDER 37 CFR 1.136.

(Restriction Requirement at page 2. (Emphasis in original.))

6. A Reply to the Restriction Requirement was filed in the USPTO on December 20, 1999. The Reply included: Request for Two-Month Extension of Time and a check for the required extension fee, Amendment and Response to Restriction Requirement Pursuant to 35 U.S.C. § 121 including a "Sequence Listing" on substitute pages 75-101, Transmittal Letter for Diskette Containing Sequence Listing, and a computer diskette containing a copy of the "Sequence Listing" in computer readable form. (Exhibit E, copy of post card receipt stamped DEC 20 1999.)
7. Although the "Sequence Listing" filed on December 20, 1999 was filed with a two-month extension of time, it appears that the USPTO considered it to be timely, as the "Sequence Listing" was entered into the application.
8. This application was transferred to this firm in October 2003, and the undersigned became aware of the facts set forth above on September 2, 2004.

Applicant petitions the Director under 37 C.F.R. § 1.181(a)(3) to exercise his supervisory authority and declare that the "Sequence Listing" filed on December 20, 1999, with a two-month extension of time, was filed timely. This petition should be granted because the shortened and non-extendable period to file a "complete reply" set by the Examiner in the Restriction Requirement is ambiguous, appears to have been set in error, and conflicts with the USPTO policy regarding compliance with the sequence rules that was in effect at the time the Restriction Requirement was mailed.

Prior to receiving the Restriction Requirement (with attached Notice to Comply), Applicant had not received any Office Action or other USPTO Notice or Communication requiring that a "Sequence Listing" be filed in the application, or advising that the "Sequence Listing" on file was defective or damaged. In fact, the "Sequence Listing" on file at the time the Restriction Requirement was mailed was not filed in reply to any PTO communication, but was a voluntary submission. Accordingly, that "Sequence Listing" is not a "response" or "reply." Thus, the Examiner's statements in the Restriction Requirement indicating that "the response appears to be **bona fide**," and setting an apparently non-extendable one-month period for filing a complete response under 37 C.F.R. § 1.135(c) appear to have been made in error, because there

was no prior incomplete “response.” (Restriction Requirement at page 2.) 37 C.F.R. § 1.135(c) appears inapplicable under the circumstances.

The one-month non-extendable period for filing a complete response apparently set by the Examiner also conflicts with USPTO policy regarding compliance with the sequence rules in effect at the time the Restriction Requirement was mailed. In particular, the Manual of Patent Examining Procedure (MPEP) in effect at the time the Restriction Requirement was mailed instructs:

Upon detection of damage or a deficiency [in the “Sequence Listing” or computer readable form], a notice will be sent to the applicant detailing the damage or deficiency and setting at least a 30-day period for reply. The period for reply will usually be 1 month. However, if the notice is sent out with an Office communication having a longer period for reply, the period for reply may be longer than 1 month, e.g., where the notice is sent with an Office action on the merits setting a 3-month period for reply. Extensions of time in which to reply will be available pursuant to 37 CFR 1.136.

MPEP § 2421.03, pp. 2400-18, 7th Ed. (July 1998) (Emphasis added.) (Copy provided as Exhibit F.).

The Notice to Comply that was attached to the Restriction Requirement in this application was the first and only notice sent to the Applicant advising that the “Sequence Listing” on file was damaged or deficient. The Examiner followed USPTO policy and appropriately set a one-month period for complying with the sequence rules in the Restriction Requirement. (Id.) However, MPEP § 2421.003 (7th Ed. (July 1998)) makes clear that the one-month period should have been extendable pursuant to 37 C.F.R. § 1.136. (Id.)

For the foregoing reasons the “Sequence Listing” filed December 20, 1999 with a two-month extension of time should be considered to have been timely filed by the USPTO.

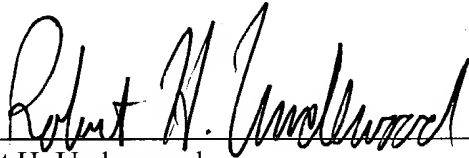
To the extent that it may be necessary, please consider this paper as a Petition under 37 C.F.R. § 1.183 to waive 37 C.F.R. §§ 1.134 and 1.136(a)(1)(i) with respect to the “Sequence Listing” filed on December 20, 1999.

Authorization to charge any petition fees under 37 C.F.R. § 1.17(h) due in this matter to Deposit Account Number 08-0380 is hereby granted. Please charge any deficiency or credit any overpayment in the fees that may be due in this matter to Deposit Account No. 08-0380. A copy of this letter is enclosed for accounting purposes.

The USPTO is invited to contact the undersigned if they feel that a telephone conference would expedite resolution of this matter.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By 
Robert H. Underwood
Registration No. 45,170
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133

Dated: *October 27, 2004*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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For the foregoing reasons the "Sequence Listing" filed December 20, 1999 with a two-month extension of time should be considered to have been timely filed by the USPTO.

To the extent that it may be necessary, please consider this paper as a Petition under 37 C.F.R. § 1.183 to waive 37 C.F.R. §§ 1.134 and 1.136(a)(1)(i) with respect to the "Sequence Listing" filed on December 20, 1999.

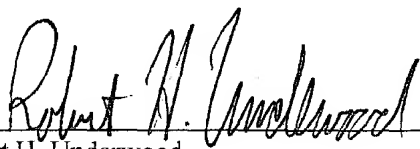
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Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By



Robert H. Underwood

Registration No. 45,170

Telephone: (978) 341-0036

Facsimile: (978) 341-0136

Concord, MA 01742-9133

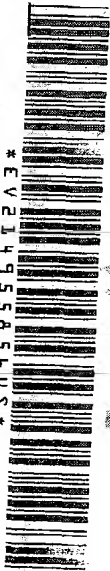
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